

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Jorge SEVILLA ABELLAN et al.

Serial No.: 10/561,012

Filed: December 11, 2006

For: Databases Synchronization

Examiner: MAHMOOD, Rezwanul
Group Art: 2164

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

This Pre-Appeal Brief Request for Review ("Request") is submitted in accordance with the U.S.P.T.O. Official Gazette Notice "New Pre-Appeal Brief Conference Pilot Program," dated July 12, 2005. The present Request is filed concurrently with a Notice of Appeal and is filed before the filing of an Appeal Brief. No amendments are being filed with this request.

Arguments supporting the Request begin on page 1 of this paper.

REMARKS

This Request is filed in response to the final Office Action dated August 14, 2009. Claims 2-4, 6-8, and 10-12 are pending in this application, with claims 10 and 12 being independent.

In the final Office Action, claims 2-4, 6, 7, and 10-12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over a combination of three references: U.S. Patent 6,505,215 (“Kruglikov”) in view of U.S. Patent 6,824,064 (“Guthery”), and further in view of U.S. Patent 6,779,002 (“Mwaura”).¹ Claim 8 stands rejected as unpatentable over Kruglikov in view of Guthery, Mwaura, and U.S. Patent 6,676,022 (“Guthery ‘022”).

The alleged *prima facie* case in support of the rejection of independent claims 10 and 12 suffers from at least the following clear deficiencies: (1) the cited references do not disclose all of the elements of claims 10 and 12; and (2) the Examiner has failed to show proper or sufficient motivation for combining the cited references.

The embodiments disclosed in the present application are concerned with the synchronization of a database contained in mobile equipment, such as a mobile phone (i.e. the “mobile first data processing system”), with a database contained in a network operator server (i.e. the “second data processing system”). An operator or network-supplied application is loaded into a security token, such as a SIM card, that is coupled to the mobile equipment. The application is operable to request that the mobile equipment start a synchronization process between the database stored in the mobile equipment and the database stored in the network operator server in accordance with a specific operator/network synchronization policy.

Claim 10 thus recites, *inter alia*, “loading an application into the security token coupled to the mobile first data processing system, the application being operable to request that the mobile

¹ The Office Action, at page 6, erroneously includes claims 8 and 9 in the statement of this rejection. Claim 8 was rejected on other grounds, and Claim 9 was previously cancelled.

first data processing system start a synchronization process of the first database with the second database according to a synchronization policy.” Claim 12 similarly recites these features.

Kruglikov discloses a system for synchronizing a portable system (110), e.g, a handheld device, with a personal computer (150). The Examiner concedes that Kruglikov does not disclose “a security token coupled to the mobile first data processing device, loading the application in the security token,” but purportedly finds “an application in the mobile first data processing system, the application being operable to request that the mobile first data processing system start a synchronization process of the first database with the second database according to a synchronization policy.” (Office Action at page 4).

However, the portions of Kruglikov cited by the Examiner disclose only user-initiated synchronization, i.e., synchronization which is initiated by a user by placing the portable system in a cradle (see, e.g., col. 4, lines 35-38). The Examiner has not identified anything in Kruglikov that teaches or suggests an application “operable to request that the mobile first data processing system start a synchronization process of the first database with the second database according to a synchronization policy,” as recited in claims 10 and 12.

The Examiner cites Guthery as purportedly teaching “a security token coupled for communication with the mobile first data processing system and an application being loaded into the security token.”

Guthery relates to a smart card capable of storing a number of applications and a memory that is logically partitioned into a number of memory blocks. Guthery’s system seeks to allow simultaneous communication with more than one of the applications. To do so, it is necessary to dynamically allocate the scarce memory of the smartcard. This is done using a control program stored on the smartcard. (See Abstract of Guthery and col. 2, lines 52-58).

Guthery does not address database synchronization and, therefore, does not teach or suggest an application “operable to request that the mobile first data processing system start a synchronization process of the first database with the second database according to a synchronization policy,” as recited in claims 10 and 12. Guthery, therefore, does not remedy the deficiencies of Kruglikov, discussed above, with respect to these claimed features.

The Examiner contends that Guthery broadly teaches “loading the application in the security token.” However, Guthery does not teach that any application can or should be loaded into the smartcard, as the Examiner suggests. Rather, Guthery simply teaches the use of multiple conventional security-related applications on a smart card, such as for use with credit card terminals, automated teller machines (ATMs), and mobile phones, with the addition of a memory administration program that allows simultaneous communication with these applications while dynamically allocating the smartcard’s scarce memory:

The present invention provides tight linkage between the communication with smart card applications, allocation of scarce resources within the smart card, and the scheduling of execution of those applications. The system and method is constructed to embrace and be compatible with current modes of smart card usage.

(Guthery at col. 7, lines 36-42).

Therefore, even if one were to assume, *arguendo*, that Kruglikov discloses the claimed application “operable to request that the mobile first data processing system start a synchronization process of the first database with the second database according to a synchronization policy,” as the Examiner contends, the combination of Kruglikov and Guthery would not teach or suggest loading a synchronization program into the smartcard. Rather, this combination of references would, at most, teach the use of a smartcard as a security device, with the synchronization program being stored on the portable system, rather than in the smartcard.

Thus, even under this assumption, the combination of Kruglikov and Guthery still would not teach or suggest “loading an application into the security token coupled to the mobile first data processing system, the application being operable to request that the mobile first data processing system start a synchronization process of the first database with the second database according to a synchronization policy,” as recited in claims 10 and 12.

The third cited reference, Mwaura, discloses a computer software framework and method for synchronizing data across multiple databases involving the exchange of data synchronization messages. The Examiner cites Mwaura as purportedly teaching receiving a message by an application and determining if synchronization is needed by checking whether the message is relevant and, if so, taking a synchronization action. However, nothing has been found in Mwaura that would remedy the deficiencies of the combination of Kruglikov and Guthery with respect to the features of claims 10 and 12 discussed above.

Therefore, the Examiner’s *prima facie* case in support of the rejection of independent claims 10 and 12 suffers from the clear deficiency that the cited references do not disclose the claimed feature: “loading an application into the security token coupled to the mobile first data processing system, the application being operable to request that the mobile first data processing system start a synchronization process of the first database with the second database according to a synchronization policy.”

Regarding motivation to combine the cited references, the Examiner, citing Guthery, asserts:

[I]t would have been obvious to a person of ordinary skill in the art . . . to modify the teachings of Kruglikov with the teachings of Guthery to have a data processing system include a security token controlled by an operator and load an application into the security token to move the administration of simultaneous communication with multiple applications on a smart card into the smart card itself.

(Office Action at pages 4-5, emphasis added). However, the rationale offered by the Examiner merely addresses why one of ordinary skill in the art would have: (1) combined a smart card security device with Kruglikov's portable system; and (2) included a multiple-application administration program on the smart card itself. The Examiner's rationale does not address why one of ordinary skill in the art would have loaded a portable/remote database synchronization program into the smart card.

Therefore, the *prima facie* case in support of the rejection of independent claims 10 and 12 suffers from the clear deficiency that the Examiner has failed to show proper motivation for the proffered combination and modification of the cited references necessary to support the rejections.

In view of the above, it is submitted that *prima facie* obviousness has not been established with respect to claims 10 and 12. Accordingly, it is requested that the rejection of claims 10 and 12 under 35 U.S.C. § 103, and of all of the claims depending from these claims, be withdrawn.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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